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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/646,150

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Sheldon H. Foss JR.

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EXAMINER

ROSEN, ELIZABETH H

ART UNIT

PAPER NUMBER

3692

MAIL DATE

DELIVERY MODE

08/17/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/646,150	Applicant(s) FOSS ET AL.	
	Examiner Elizabeth H. Rosen	Art Unit 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6,8-11,13 and 15-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6,8-11,13 and 15-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is in reply to the Request for Continued Examination filed on May 18, 2009.
2. Claims 1-4, 6, 8, 11, and 21 have been amended.
3. Claims 5, 7, 12, and 14 have been canceled.
4. Claims 1-4, 6, 8-11, 13, and 15-23 are currently pending and have been examined.

Response to Arguments

5. The rejections under 35 U.S.C. 103 are presently withdrawn. As explained below in the rejections under the second paragraph of 35 U.S.C. 112, the data aggregation steps are written in a manner that could be interpreted to mean that a single customer's transaction data is aggregated and then used to qualify the customer for a new account and/or manage the customer's existing and new accounts. If the claims are not amended to exclude this interpretation, which is believed to not be Applicant's invention, a rejection under 35 U.S.C. 103 would be proper.
6. With regard to the rejections under 35 U.S.C. 101 and 35 U.S.C. 112, Applicant should refer to the rejections below for an explanation of these rejections.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
8. **Claims 11, 13, and 15-20** are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In *re Bilski et al*, 88 USPQ 2d 1385 CAFC (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).
9. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively

recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

10. Here, Applicant's method steps fail the first prong of the new Federal Circuit decision since they are not tied to a machine and can be performed without the use of a particular machine. Thus, these claims are non-statutory since they may be performed within the human mind.

11. The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.

12. The limitations of these claims must be performed by a computer or processor.

Claim Objections

13. **Claim 11** is objected to because of the following informalities: Claim 11 includes "at least one the existing financial accounts." If Applicant intends this to be "at least one of the existing financial accounts," Applicant should make the appropriate correction.

Claim Rejections - 35 USC § 112, First Paragraph

14. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

15. **Claims 1-4, 6, 8-11, 13, and 15-23** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These claims have been amended to include a computer (processor and memory). Because the specification does not include any description of the claimed invention being performed by a computer or machine, this is new matter.

16. There is no indication in the specification that this invention is to be performed by a computer or processor. Likewise, the specification filed with the provisional application (60/466,494) does not explain the invention being performed by a computer or processor. However, a document that was filed with the

provisional application does include a computer. Page 17 of this document states that “[t]he James/ Foss system is a collection of integrated computer softwares and proprietary algorithms, methods of work, business processes, and risk models that enable the analysis/issuance/distribution/monitoring of an integrated credit product that extends credit through host based stored value and an unsecured credit line.” Page 17 further states “[t]he James/Foss system gives the service provider the ability to underwrite and integrate an extension of credit to a consumer through purchase/acquisition of a host based stored value or financial transaction vehicle.” The page further includes a drawing that has a processing system. Nowhere does this document suggest that a computer or processor is used to perform the claimed invention. In order for the provisional and non-provisional applications to include sufficient support for amendments made for 35 U.S.C. 101, they must describe the claimed embodiments as being performed by a computer or processor. More specifically, with regard to the method claims, the inventive features must be performed by a computer or processor. The mere mention of a computer that is used to perform non-claimed tasks is insufficient to provide support for the claims.

Claim Rejections - 35 USC § 112, Second Paragraph

17. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

18. **Claims 1-4, 6, and 8-10** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 includes the limitation of “a decision engine operable to qualify the new customer for a new financial account based at least in part on qualification criteria and said formation data and said account option data.” If the decision engine includes software that is performed on a computer, it would necessarily be operable to perform any function that a computer can perform. For example, any computer can be operable to qualify customers for accounts. In order to give patentable weight to the latter portion of the limitation, the decision engine should be “configured” to perform the claimed function. This also applies to the data collection component, account creation component, account management component, and transactional processing component. Claims 2-4, 6, and 8-10 are rejected for similar reasons.

19. **Claims 1-4, 6, 8-11, 13, and 15-23** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 includes the limitation of “the data aggregation module configured to aggregate data associated with the transaction and provide feedback information related to the aggregated transaction data to the decision engine and the account management component.” It is

unclear whether the aggregated data includes data of more than one account/customer. It is assumed that Applicant intends that data among many customers is aggregated and then fed into the decision engine and account management components. However, the language of this claim can be reasonably interpreted to mean that data is aggregated for each account or customer separately. This interpretation yields an invention that is well known in the art (see at least Sanchez, Paragraph 0061). To distinguish the claimed invention from prior art and clarify how the claim is to be interpreted, the claim should be amended to make it clear that the data aggregation module aggregates data associated with all (or at least a plurality of) accounts and those accounts belong to more than one customer. Claims 2-4, 6, 8-11, and 15-23 are rejection for similar reasons. For example, the first limitation of Claim 11, "aggregating transaction data regarding a plurality of existing financial accounts," could be interpreted to mean that data is aggregated for all accounts of one customer and then that data is used to modify services of that customer or to qualify that customer for a new account. The possible interpretation of these claims appears to be distinct from the invention disclosed in Applicant's specification.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Rosen whose telephone number is 571-270-1850. The examiner can normally be reached on Monday - Friday, 9:30 am - 6:00 pm, ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached at 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Elizabeth H Rosen
Examiner, Art Unit 3692

/Kambiz Abdi/
Supervisory Patent Examiner, Art Unit 3692